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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/642,744	08/18/2000	Brian F. Tack	IOWA:026US	7819

7590 09/22/2005

Stephen M. Hash
FULBRIGHT & JAWORSKI L.L.P
Suite 2400
600 Congress Avenue
Austin, TX 78701

EXAMINER

MINNIFIELD, NITA M

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 09/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/642,744

Applicant(s)

TACK ET AL.

Examiner

N. M. Minnifield

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 34-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34 is/are allowed.
- 6) ☒ Claim(s) 1,3,47 and 48 is/are rejected.
- 7) ☒ Claim(s) 35-55 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Response to Amendment

1. Applicants' amendment filed August 12, 2005 is acknowledged and has been entered. Claims 2 and 4-33 have been canceled. Claims 1 and 3 have been amended. Claims 1, 3 and 34-55 are now pending in the present application. All rejections have been withdrawn in view of Applicants' amendment to the claims and/or comments, with the exception of those discussed below.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. The disclosure is objected to because of the following informalities: see Tables 8A and 8B found on pages 77-79 of the specification; these tables recite amino acid sequences. However, the sequences have not been identified using sequence identifiers. Appropriate correction is required.

This application contains sequence disclosures (see above paragraph) that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 C.F.R. § 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 C.F.R. §§ 1.821-1.825 for the reasons set forth above.

Full compliance with the sequence rules is required in response to this office action. A complete response to this office action should include both compliance with the sequence rules and a response to the FINAL Office Action set

forth below. Failure to fully comply with **both** these requirements in the time period set forth in this office action will be held non-responsive.

4. Claims 47 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 47 and 48 recite the limitation of amino acid sequence SEQ ID NO: 19 and amino acid sequence of SEQ ID NO: 20 respectively in line 2 of each claim. There is insufficient antecedent basis for this limitation in the claim.

5. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Larrick et al (5618675).

Larrick et al discloses a peptide comprising the amino acid sequence of SEQ ID NO: 24 (see SEQ ID NO: 7 and 11 of Larrick et al; attached sequence search result printouts). The Larrick et al sequences contain 29 and 16 amino acid residues respectively; which is within the claimed range of 12-37 residues. SEQ ID NO: 7 of Larrick et al is a 100% match with claimed SEQ ID NO: 24. Larrick et al discloses compositions comprising the peptides in a suitable pharmaceutical carrier (i.e. a pharmaceutical composition) (abstract; cols. 9-10).

The recitation of “antimicrobial” is intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada* 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01.

6. Claims 1 and 3 are rejected under 35 U.S.C. 102(e) as being anticipated by Larrick et al (6103888).

Larrick et al discloses a peptide comprising an amino acid sequence of SEQ ID NO: 24 (see SEQ ID NO: 7 and 11 of Larrick et al; attached sequence search result printouts). The Larrick et al sequences contain 29 and 16 amino acid residues respectively; which is within the claimed range of 12-37 residues. SEQ ID NO: 7 of Larrick et al is a 100% match with claimed SEQ ID NO: 24. Larrick et al discloses compositions comprising the peptides in a suitable pharmaceutical carrier (i.e. a pharmaceutical composition) (abstract; cols. 9-10).

The recitation of “antimicrobial” is intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Products of identical chemical composition cannot have mutually exclusive properties. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01.

7. With regard to the 102(e) rejection of claims 1 and 3 over Larrick et al (5618675 and 6103888) as set forth in item numbers 5 and 6, the rejections are maintained for the reasons of record. Applicant's arguments filed August 12, 2005 have been fully considered but they are not persuasive. Applicants have asserted that independent claims 1 and 3 do not recite SEQ ID NOS: 19 and 24. Applicants are correct that claims 1 and 3 do not recite SEQ ID NO: 19, however the amendment to the claims filed August 12, 2005 still recites SEQ ID NO: 24 in both independent claims 1 and 3. Because the claims still recite SEQ ID NO: 24 this rejection is still proper. Both patents, 5618675 and 6103888, disclose the claimed invention with regard to the recitation of SEQ ID NO: 24 in claims 1 and 3.

8. Claims 35-55 are objected to because of the following informalities: because these claims depend from rejected independent claim 1. Appropriate correction is required.

9. Claim 34 appears to be allowable.

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.**

See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

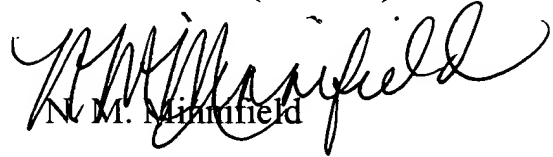
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. M. Minnifield whose telephone number is 571-272-0860. The examiner can normally be reached on M-F (8:00-5:30) Second Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette R.F. Smith can be reached on 571-272-0864. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->

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direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "N. M. Minnifield", written over the printed name.

N. M. Minnifield

Primary Examiner

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NMM

September 18, 2005